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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,112	03/30/2004	Teiyu Goto	SCEP 21.084 (100809-00238)	5160
26304 7590 12/27/2006 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER MAGEE, CHRISTOPHER R	
			ART UNIT 2627	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/814,112

Applicant(s)

GOTO, TEIYU

Examiner

Christopher R. Magee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amended claim 9 and newly submitted claims 13-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Both inventions, the disc cartridge and the disk device/processing device are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the disk device/processing device has separate utility such as reproducing the information on the recording medium as taught by Bloch et al. (US 5,745,102). See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9 and 13-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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- Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schick et al. (hereinafter Schick) (US 5,995,346) in view of Ohira (JP 11-120740).

- Regarding claim 1, Schick discloses a disk cartridge, comprising:

- a cartridge main body 10; and

- a round plate-shaped disk 14 rotatably housed within the cartridge main body,

- the cartridge main body including an opening facing the disk and a shutter 16, which opens and closes the opening, wherein a part of the cartridge main body is formed in an approximately semicircular shape [col. 3, lines 22-29; Figures 2 and 6].

- Regarding claim 3, Schick shows the shutter 16 has the same axis of rotation as that of the disk and is pivotably provided for the cartridge main body [Figure 4].

- Regarding claims 5 and 7, Schick shows the cartridge main body has a groove 35 formed in a direction in which the disk cartridge is inserted into a drive device, the groove 35 having an end at a part of a circumferential portion of the region in the approximately semicircular shape [Figure 2]; and

- the shutter 16 has a projecting portion 17 protruding toward the groove 35 [col. 5, lines 13-16; Figure 2].

- Regarding claim 9, Schick discloses a drive device to which a disk cartridge is inserted, comprising:

- a mechanism which is engaged with a projecting portion of a shutter, the projection portion protruding toward a groove formed in the cartridge main body, so as to turn the shutter to open it when the disk cartridge is inserted [col. 5, line 59 to col. 6, line 3; Figures 8A-8F].

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- Referring to claim 4, Schick shows the shutter 16 has the same axis of rotation as that of the disk and is pivotably provided for the cartridge main body [Figure 4].

- Referring to claims 6 and 8, Schick shows the cartridge main body has a groove 35 formed in a direction in which the disk cartridge is inserted into a drive device, the groove 35 having an end at a part of a circumferential portion of the region in the approximately semicircular shape [Figure 2]; and

the shutter 16 has a projecting portion 17 protruding toward the groove 35 [col. 5, lines 13-16; Figure 2].

Regarding claims 2, 10 and 11, Schick teaches all the features, *supra*, except the cartridge main body having electric terminals in a region other than a region in the approximately semicircular shape and that transmit electronic signals indicating the type of the medium from the electric terminal to the external device.

In regards to claims 2 and 10-12, Ohira teaches electronic circuitry 7 with terminals 3 equipped with condition control means which controls the playback conditions of the disk, and information management means [section 0073-0077]. Ohira also discloses a disk device 9 that executes a process in accordance with the type of medium [Figure 5].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the disk cartridge of Schick with electric terminals as taught by Ohira.

The rationale is as follows: One of ordinary skill in the art at the time of the invention would have been motivated to provide the disk cartridge of Schick with electric terminals as taught by Ohira in order to properly identify the type of medium [Ohira; section 0148-0149].

Response to Arguments

3. Applicant's arguments with respect to claims 1-8, 10 and 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Magee whose telephone number is (571) 272-7592. The examiner can normally be reached on M-F, 8: 00 am-4: 30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher R. Magee

Patent Examiner

Art Unit 2627

December 19, 2006

crm



ANDREA WELLINGTON
SUPERVISORY PATENT EXAMINER